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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

KINDRED, ALFORD W

ART UNIT	PAPER NUMBER
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2163

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/768,606

Applicant(s)

BUSEY ET AL.

Examiner

Alford W. Kindred

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,28,48 and 69-97 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,28,48,72,73,77,86,87,89,93,94 and 96 is/are rejected.
- 7) ☒ Claim(s) 69-71, 74-76, 78-85, 88, 90-92, 95 and 97 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This action is responsive to communications: RCE, filed on 05/3/06.

Allowable Subject Matter

2. Claims 69, 70-71, 74-76, 78-85, 88, 90-92, 95 and 97 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: the prior art of record fails to teach and/or suggest "establishing a browser region including a browser frame controlled by a browser client on a display device . . . a chat region controlled by a chat client within the browser region . . . chat content including a link to a web page, the chat client effecting displaying of the chat content . . . the browser client obtaining from a server the web page that corresponds to the link and displaying the obtained web page . . .", combined with "controlling the browser region except for contents of the chat region displayed on the display device . . . the chat text with a chat server via a second communication connection that is a real time continuously open bi-directional communications connection."

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 10 and 28 are rejected under the judicially created doctrine of double patenting over claims 1 and 17 of U. S. Patent No. US# 6,785,708 B1 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: claims 10 and 28 of the instant application recite establishing a chat region controlled by a browser while Claims 1 and 17 of Patent recite "establishing browser and chat region on a first display". The establishing of chat regions in browsers and displays includes the ability to process chat functions and thus, the applications claims of 10 and 28 are obvious over the Patent's claims 1 and 17

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Claim Rejections - 35 U.S.C. § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 10, 28, 48, 72-73, 77, 86-87, 89, 93-94 and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Volano, "VolanoChat Java solution turns ordinary web sites into interactive money makers", Business Wire, pp.1-2, in view of Judson, U.S. Patent Number 5,572,619, filed 10/19/95, class 395/793, title "Web browser with dynamic display of information objects during linking", and further view of Donath et al., 1996.

With respect to claim 10, 48, and 72, Volano discloses, "establishing a chat region controlled by a chat client" ("VolanoChat works with all Java-compatible browsers . . . can accommodate large numbers of simultaneous real-time interactions . . . such as browser plug-ins, Internet chat . . ."--page 1 of 2). Volano does not disclose "a browser frame controlled by a browser client . . .". Anupam discloses "a browser frame

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controlled by a browser client . . . with the browser region" (see fig. 1,--sheet 1 of 4. It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Anupam and Volano above, because using the steps of a browser client that is controlled by a browser frame, would have given those skilled in the art the ability to incorporate chat functions in a user's browser. Volano does not disclose "in response to a command received by a computer, establishing a browser . . .". Judson discloses "in response to a command received by a computer, establishing a browser . . ." ("client machine having a browser, wherein the information objects are downloading of a hypertext object, selectively displaying one of the stored information objects . . ."--column 10, line 53). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Judson "in response to a command received by a computer, establishing a browser . . ." ("client machine having a browser, wherein the information objects are downloading of a hypertext object, selectively displaying one of the stored information objects . . ."--column 10, line 53) with the teachings of Volano above, because using the steps of "in response to a command received by a computer, establishing a browser . . ." would have given those skilled in the art the tools to create a browser in the an Internet environment. This gives users the ability to user browsers to view and manipulate information on the Internet via commands of a computer. Volano does not explicitly teach "the chat region being a real time . . . chat region synchronized with the browser region; in response to receiving chat content including a link to a web page . . . detecting selection, by a user of the display device . . . invoking the browser client . . .

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the link and displaying the obtained web page in the browser region" (see pages 1-4).

Donath et al. teaches "the chat region being a real time . . . chat region synchronized with the browser region; in response to receiving chat content including a link to a web page . . . detecting selection, by a user of the display device . . . invoking the browser client . . . the link and displaying the obtained web page in the browser region" (see pages 1-4). It would have been obvious at the time of the invention for one of ordinary skill in the art to have combined the teachings of Volano and Donath because using the steps of "the chat region being a real time . . . chat region synchronized with the browser region; in response to receiving chat content including a link to a web page . . . detecting selection, by a user of the display device . . . invoking the browser client . . . the link and displaying the obtained web page in the browser region", would have given those skilled in the art the tools to link web page data while also detecting and manipulating chat content in a fashion illustrated in applicant's claim language above. This give users the advantage of improving the transmission of chat content more efficiently.

With respect to claim 28, this claim is rejected on grounds corresponding to the arguments given above for rejected claim 10 and is similarly rejected.

With respect to claims 73 and 77, **Volano** discloses "the chat client detecting a user of the computer selecting a hyperlink in the chat text displayed . . . web page . . ." ("chat technologies, such as browser plug-ins . . ."--page 1 of 2).

With respect to claim 89, this claim is rejected on grounds corresponding to the arguments given above for rejected claims 10 and 72 and is similarly rejected

With respect to claims 94 and 96, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10 and 72 and are similarly rejected.

With respect to claims 86-87, these claims are rejected on grounds corresponding to the arguments given above for rejected claims 10 and 72 and are similarly rejected

Response to Arguments

6. Applicant's arguments filed 05/03/06 have been fully considered but they are not persuasive.

--As per applicant's arguments regarding "that is, a user can select a link in a chat region to display a web page in the browser frame, while continuing to chat . . . references fail to disclose or suggest . . .", examiner disagrees and argues that Donath's teachings of chat regions on pages 2-3 which includes the linking to others within a web chat session, clearly involves the synchronization of browsers, for connection purposes, as illustrated in applicant's claim language.

--As per applicant's arguments regarding "Anupam neither discusses users selecting links nor a browser to synchronize link selection within a chat session and browsing functions, because all browsing is controlled by the originator", examiner refers applicant to Anupam's teachings of a browsing element in a collaborative forum of computer participants working together, combined with Donath's teachings of the

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synchronization of chat regions in a browser, reads on applicant's amended claim language above.

--In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, references Volano, Anupam, Judson and Donath, are related in the fact that each reference teach the element of browsers being used in connection with some type of chat communications over a networking system which similar to applicant's claim language and thus, the use of the combination of references above is proper. Further the motivation to combined the above references above would have been recognized by those of ordinary skill in the art at the time of the invention.

--As per applicant's arguments regarding "Donath explicitly recites . . . a service that requires a non-standard browser is not practical solution' . . ." examiner considers that above quote as demonstrating that the Donath reference understood and recognize the benefit/detriment of using a non-standard browser for various purposes and thus had knowledge and understanding of the use of non-standard browsers at the time of the invention. Thus, examiner maintains the Donath reference teachings of non-standard browsers read on applicant's claim language.

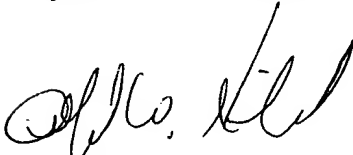
--As per applicant's arguments regarding Donath describes allowing a chat session to continue despite a user deciding to browse pages outside of a chat session . . . applicants, however, claim chat content and a web page associated with a target such that in response to selection of the target, both the chat session and the web pages are changed to those associated with the target . . .", examiner maintains a that Donath's teachings of chat sessions being continuous through various links on a web page includes the chat content and a web page being changed according to the selection of a target element as indicated in applicant's claim language.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alford W. Kindred whose telephone number is 571-272-4037. The examiner can normally be reached on Mon-Fri 9:00 am- 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on (571) 272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Alford W. Kindred
Patent Examiner
Tech Ctr. 2100